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EXAMINER

WELLS, LAUREN Q

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 10/23/2003

7

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/031,233

Applicant(s)

MOUGIN, NATHALIE

Examiner

Lauren Q Wells

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☒ None of:
- 1) ☐ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 1. 6) ☐ Other:

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### **DETAILED ACTION**

Claims 1-35 are pending. The Preliminary Amendment filed 1/17/02, Paper No. 3, amended page 1 of the specification, and claims 3-5, 7-11, 14-35.

#### ***Election/Restrictions***

Applicant's arguments are persuasive. The Election/Restriction Requirement is hereby withdrawn.

#### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-2, 5-6, 9-13, 16-17, 20-35 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 12, 13, 15, 16, 18, 20-24, 31-36, 38, 40-46 and 48-50 of copending Application No. 10/304,793. Although the conflicting claims are not identical, they are not patentably distinct from each other. The instant invention recites compositions comprising, in a physiologically acceptable medium, a rigid block having a Tg greater than or equal to 20 C and a flexible block having a Tg of less than or equal to 20 C, wherein the film produced has an instantaneous recovery of between 5 and 100%, with the exclusion of blocks consisting exclusively of ethylene, propylene, butylene,

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butadiene, and/or isoprene units. '793 teaches compositions comprising, in a physiologically acceptable medium linear block ethylene copolymers wherein one block has a Tg of less than or equal to 20 C and another has a Tg of greater than or equal to 20 C. '793 fails to teach an instantaneous recovery.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to teach the block copolymers of '793 as forming a film with an instantaneous recovery of between 5-100% because '793 and the instant invention teach the same block copolymers. Thus, one of skill in the art would be motivated to teach the block copolymers of '793 as having an instantaneous recovery of between 5-100%.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(i) The phrase "characterized in that" in claims 2-29 renders these claims vague and indefinite, as the metes and bounds of these claims are unascertainable. This phrase is not a positive recitation, but only requires the ability to so perform that function.

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(ii) The term “certain” in claims 3, 4 and 14-15 is vague and indefinite, as the metes and bounds of these claims are unascertainable. The specification does not define what these “certain” compounds would be and one of skill in the art would not be apprised of what compounds Applicant is referring to.

(iii) The phrase “amine function” in claims 3 and 14 (line 10) is vague and indefinite, as it is not clear what an amine function is. Is it an amine? Is it a precursor to an amine? Is it something that functions like an amine, but is structurally unrelated to an amine?

(iv) A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by “such as” and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claims 10 and 21 recite the broad recitation “from 5-95%”, and the claims also recite “preferably between 10-90%, in particular between 20-80% and ideally between 55 and 78%” which is the narrower statement of the range/limitation; claims 11 and 22 recite the broad recitation “from 10-60%” and from “40-90%, and the claims also recite “in particular from 15-50%” and “in particular from 50-85%” which is the narrower statement of

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the range/limitation; claim 23 recites the broad recitation “from 1-99%”, and the claim also recites “preferably from 5-50% by weight and most particularly from 7-40% by weight” which is the narrower statement of the range/limitation; claim 9 recites the broad recitation “at least equal to 20 C”, and the claim also recites preferably greater than 50 C and ideally greater than 100 C” which is the narrower statement of the range/limitation.

(v) The Markush language in claim 28 is vague and indefinite, as it is confusing. Why are antioxidants recited twice? Why are antioxidants and free-radical scavengers individually recited, as these two terms are synonymous?

(vi) Claims 1-11 and 33-35 provide for the use of a cosmetic, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claims 1-11 and 33-35 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

(vii) Claims 8 and 18 are vague and indefinite, as they are confusing. Do A and B recited in claims 8 and 18, refer to (a) and (b) recited in claims 1 and 12?

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 12-16, 18, 20-29, and 31-32 are rejected under 35 U.S.C. 102(b) as being anticipated by Kuentz et al (5,711,940).

Kuentz et al. teach microdispersions of particles comprised of acrylic polymers in an organic solvent in the presence of a block copolymer, characterized in that said acrylic polymer is obtained by radical polymerization of at least one acrylic monomer in the presence of a block copolymer based on polymethyl methacrylate (PMMA-Tg of greater than or equal to 20C) and polytert-butyl acrylate (PTBuA-Tg of less than or equal to 20C). Exemplified is a nail varnish comprising a diblock copolymer of PtBuA-p-PMMA, nitrocellulose (fatty substance of synthetic origin), arylsulfonamide resin, polyester resin, butylacetate/ethyl acetate/toluene mixture (fatty substance of synthetic origin), plasticizer, suspending agent, and pigments (wherein pigments are synonymous to colorants).

Further exemplified is a triblock polymer (BAB) of PtBuA-b-PMMA-b-PTBuA, wherein ethanol is exemplified as the solvent, and wherein PtBuA comprises 54% of the three-block copolymer. The block copolymer is contained in the composition in an amount between 1-99%.

While an instantaneous recovery of between 5-100% is not explicitly taught, the above exemplified composition has this property since the tri-block polymer exemplified above is taught as a preferred block copolymer in the instant invention.

The Examiner respectfully points out that instant claim 13 is a product-by-process claim. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on

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its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). See MPEP 2113.

Claims 12-21, 24, 28, 29 are rejected under 35 U.S.C. 102(b) as being anticipated by Varshney et al.

Varshney et al. exemplify a tri-block copolymer (ABA) of (methyl methacrylate-*b*-*tert*-butyl acrylate-*b*-methyl methacrylate), wherein the copolymer is in a mixture of 80 parts methanol (alcohol), 20 parts water and stabilized with an antioxidant. See Col. 10, lines 10-45.

The Examiner respectfully points out that the recitation “cosmetic” has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

While an instantaneous recovery of between 5-100% is not explicitly taught, the above exemplified composition has this property since the tri-block polymer exemplified above is taught as a preferred block copolymer in the instant invention.

The Examiner respectfully points out instant claim 13 is a product-by-process claim. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on



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its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). See MPEP 2113.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kuentz et al. as applied to claims 12-16, 18, 20-29, and 31-32 above, and further in view of Lang et al. (4,726,942).

The instant invention is directed toward a composition comprising, in a physiologically acceptable medium, at least one block ethylene copolymer of elastic nature comprising (a) at least one rigid block having a Tg of greater than or equal to 20 C, consisting of units derived from one or more ethylenic monomers, and (b) at least one flexible block having a Tg of less than 20 C, consisting of units derived from one or more ethylene monomers, said copolymers allowing the production of a film having an instantaneous recovery of between 5 and 100%.

Kuentz et al. is applied as discussed above. The reference lacks hair lacquers.

Lang et al. teach hair lacquers and makeup-products, such as nail varnishes as interchangeable cosmetic forms. See Col. 7, line 65-Col. 8, line 5.

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It would have been obvious to one of ordinary skill in the art at the time the invention was made to teach the compositions of Kuentz et al. in the form of hair lacquers, as taught by Lang et al., because Lang et al. teach nail varnishes and hair lacquers as interchangeable cosmetic forms.

Claims 17 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kuentz et al. as applied to claims 12-16, 18, 20-29, and 31-32 above, and further in view of Lang et al. (4,726,942).

Kuentz et al. is applied as discussed above. The reference lacks preferred tri-block copolymers.

Varshney et al. teach acrylic triblock copolymers, their preparation and their application to the manufacture of elastomeric articles. Exemplified is (methyl methacrylate-b-tert butyl acrylate-b-methyl methacrylate) copolymer as a block copolymer that is particularly useful as varnishes and paints by virtue of their convertibility in air and their narrow molecular weight distribution. See Col. 1, lines 8-Col. 2, line 27; Col. 10, line 10-line 59.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the (methyl methacrylate-b-tert butyl acrylate-b-methyl methacrylate) copolymer taught by Varshney et al. for those taught by Kuentz et al. because of the expectation of achieving a varnish, wherein the block copolymer has a narrow molecular weight distribution.

### ***Conclusion***


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lauren Q Wells whose telephone number is (703) 305-1878. The examiner can normally be reached on M-F (7-4:30), with alternate Mondays off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on (703)305-1877. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.

lqw

  
SREENI PADMANABHAN  
PRIMARY EXAMINER 9/8/05